

Remarks/Arguments

A. Pending Claims

Claims 1 and 5-10 have been amended. Claims 1-13 and 17-18 are pending in the case.

B. 35 U.S.C. § 112, Second Paragraph

Claims 1, 5, and 10 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner takes the position that claims 1, 5, and 10 contain one or more “clauses of intended use which renders the claim indefinite.” The Examiner states:

Specifically, claim 1 after the fourth claim limitation recites “wherein the one or more key values...”

...

Claims 5 and 10 have a similar problem with the “wherein” clause.

The Examiner relies on MPEP § 2111.04, which states:

examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) “adapted to” or “adapted for” clauses;
- (B) “wherein” clauses
- (C) “whereby” clauses.

Despite the above-quoted language from MPEP § 2111.04, none of the cases cited in MPEP § 2111.04 appear to describe a “wherein” clause found to have a limiting effect. Applicant notes, moreover, that “wherein” clauses are commonly used to introduce additional features into claims (in dependent claims, for example).

MPEP § 2111.04 cites a single case in which a clause – in particular, a “whereby” clause – was held to be not of limiting effect. The claim at issue in that case stated in part:

1. A method for trading securities between individuals, comprising:

* * *

executing a trade of the security based on information contained in the offer for consideration specified in the reply to the offer, *whereby the security is traded efficiently between the first [offering] individual and the second [replying] individual;*

* * *

Minton v. National Ass'n. of Securities Dealers, Inc., 336 F.3d 1373, 1380 (Fed. Cir. 2003)

The *Minton* court stated:

The district court was also correct in not giving weight to the “traded efficiently” phrase in the whereby clause of the executing step. A whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited. *Tex. Instruments Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 1172 (Fed.Cir.1993). That is the case here. The term “efficiently” on its face does not inform the mechanics of how the trade is executed, and nothing in the specification or the prosecution history suggests otherwise. Rather, the term “efficiently” is a laudatory one characterizing the result of the executing step. We therefore hold that the district court correctly declined to give the term the meaning *Minton* has proposed.

Minton v. National Ass'n. of Securities Dealers, Inc., 336 F.3d 1373, 1381 (Fed. Cir. 2003)

Unlike the “traded efficiently” phrase in *Minton* case, the features in Applicant’s claims introduced by the word “wherein” are not simply expressing an intended result of a recited process step, but recite additional features of a claimed process.

For the foregoing reasons, Applicant respectfully disagrees with the Examiner’s rejections under U.S.C. 112, second paragraph. Nevertheless, to expedite prosecution of the

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case, Applicant has amended claims 1, 5, and 10 for clarification. Applicant respectfully requests removal of the rejections under 35 U.S.C. 112, second paragraph.

C. Additional Remarks

Based on the above, Applicant submits that all claims are in condition for allowance. Favorable reconsideration is respectfully requested.

Applicant has enclosed a Fee Authorization for a one-month extension of time. If any additional extension of time is required, Applicant hereby requests the appropriate extension of time. If any fees are omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account Number 50-1505/5053-31201/EBM.

Respectfully submitted,

Eric B. Meyertons
Reg. No. 34, 876

Attorney for Applicant

MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. Box 398
Austin, TX 78767-0398
(512) 853-8800 (voice)
(512) 853-8801 (facsimile)

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